

Serial No. 09/456,127

Atty. Dkt. No. 003797.80027

**REMARKS**

The non-final Office Action of August 28, 2002, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 7, 10-11, 15-19, 26, 31-35, 38, and 40 have been canceled without prejudice or disclaimer. Claims 1-6, 8-9, 12-14, 20-25, 27-30, 36-37, 39, and 41-44 remain pending. New claims 45-57 have been added. Support for the added claims can be found within the specification and figures.

**Rejections under 35 U.S.C. § 102(b)**

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Cassorla et al. (U.S. Patent No. 5,146,552, hereinafter *Cassorla*). Applicants respectfully traverse this rejection. In response, applicants will demonstrate their support and address each of the points raised by the Office Action Summary in turn.

**Rejections under 35 U.S.C. § 103(a)**

Claims 5-44 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Cassorla* and Shwarts et al. (U.S. Pat. No. 6,243,071, hereinafter *Shwarts*). Applicants respectfully traverse this rejection. In response, applicants will demonstrate their support and address each of the points raised by the Office Action Summary in turn.

**Claims 1-4 and Claims 5-6, 8-9, and 12-14**

Applicants have amended independent claim 1 to incorporate some of the features of dependent claims 7 and 10. This amendment was made in order to better clarify the method of claim 1 and does not add new matter to the claim.

Amended independent claim 1 recites, among other features, "wherein the visual indicator is displayed at least partially outside of the document." In *Cassorla*, based upon coordinates 56, a *Cassorla* "bookmark" defines a last placed read notation and merely opens the electronic book to that location when the user decides to continue reading the book. However, there is clearly no visual indicator displayed at least partially outside of the document.

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For at least the above stated reasons, *Cassorla* fails to teach or suggest, "wherein the visual indicator is displayed at least partially outside of the document," as recited, among other features, in Applicants' amended independent claim 1.

In addition, amended independent claim 1 recites, among other features, "wherein the bookmark object comprises user-modifiable properties corresponding to the visual indicator." Again, *Cassorla* fails to teach or suggest this feature of Applicant's amended claim 1.

As stated above, independent claim 1 incorporates some of the features of dependent claims 7 and 10. As shown above, *Cassorla* alone fails to teach or suggest every feature of Applicants' amended claim 1. Further, *Cassorla* in combination with *Shwarts* fails to teach or suggest every feature of Applicants' claim 1.

Applicants' claim 1 is patently distinct from the *Shwarts* element, bookmark 340. Figure 17 of *Shwarts* describes the bookmark 340 element. As shown in Figure 17, the bookmark 340 is a separate element from the underlying page. Bookmark element 340 is contained within the "navigation" dialogue box of Figure 17. As shown in Figure 17, when a user chooses element 340, the referenced page, in this case page 3, is displayed without any form of a visual indicator representative of a bookmark or placemark.

In regards to dependent claim 10, the Action alleges that, "the bookmark object may be selected to display information which may be modified (*Shwarts* column 19, lines 19-42)." Yet, the cited portion of *Shwarts* fails to teach or suggest, "wherein the bookmark comprises user-modifiable properties corresponding to the visual indicator," as recited, among other features, in Applicants' claim 1. Column 19, lines 19-42 of *Shwarts* describe how a user can make notes on a screen of a device (col. 19, lines 20-21). The cited portion fails to address a bookmark object at all. Further, the cited portion clearly fails to teach or suggest, "wherein the bookmark comprises user-modifiable properties corresponding to the visual indicator," as recited, among other features, in Applicants' claim 1.

Thus, for at least the above-stated reasons, *Cassorla* and *Shwarts*, either alone or in combination, fail to teach or suggest every feature of Applicants' independent claim 1.

Claims 2-6, 8-9, and 12-14, which ultimately depend from claim 1, are patentably distinct from *Cassorla* and *Shwarts*, either alone or in combination, for the reasons set forth above, and further in view of the additional advantageous features recited therein.

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**Claims 20-25 and 27-30**

Applicants have amended independent claim 20 to incorporate some of the features of dependent claims 26 and 29. This amendment was made in order to better clarify the computer-readable medium of claim 20 and does not add new matter to the claim.

Amended independent claim 20 is directed to a computer-readable medium comprising computer-executable components for bookmarking a document rendered on a display. The computer-executable components comprising, among other features, a display component, wherein the display component is capable of causing the visual indicator to be displayed at least partially outside of the document. Claim 20 was rejected allegedly for showing the same features as found in claims 1-14. Contrary to the Action's assertion, *Cassorla* and *Shwarts*, alone or in combination, fail to teach or suggest, "wherein the display component is capable of causing the visual indicator to be displayed at least partially outside of the document," as recited, among other features, in Applicants' amended independent claim 20.

*Cassorla* and *Shwarts*, either alone or in combination, fail to teach or suggest "wherein the display component is capable of causing the visual indicator to be displayed at least partially outside of the document," as recited, among other features, in Applicants' amended claim 20. For at least the foregoing reasons, Applicants submit that amended claim 20 distinguishes over the prior art of record and is in condition for allowance. Claims 21-25 and 27-30, which ultimately depend from claim 20, are patentably distinct from *Cassorla* and *Shwarts* for the same reasons set forth above, and further in view of the novel features recited therein.

**Claims 36-37, 39, and 41-44**

Applicants have amended independent claim 36 to incorporate some of the features of dependent claims 38 and 40. This amendment was made in order to better clarify the computer-readable medium of claim 36 and does not add new matter to the claim.

Amended independent claim 36 is directed to a computer-readable medium having stored thereon a data structure comprising, among other features, the second data field comprising information identifying the part of the document being marked by the data structure is at least partially outside of the document. Claim 36 was rejected allegedly for showing the same features as found in claims 1-14. Contrary to the Action's assertion, *Cassorla* and *Shwarts*, alone or in

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combination, fail to teach or suggest this feature of Applicants' independent claim 36. As stated above in reference to claim 1, *Cassorla* describes a "bookmark" as a last page read annotation. The annotation file containing the reference to a "bookmark" is not a visual indicator. *Cassorla* fails to teach or suggest any type of data structure "comprising information identifying the part of the document being marked by the data structure is at least partially outside of the document," as recited, among other features, in Applicants' independent claim 36. For at least this reason, claim 36 and claims 37, 39, and 41-44, which ultimately depend on claim 36, are considered patently distinct from the applied art.

#### Claims 45-57

New claims 45-57 are fully supported by the specification and are believed allowable over the art of record. For example, teachings of a second visual indicator as recited, among other features, in new claims 45 and 57 cannot be found in either *Cassorla* or *Shwarts*. Indeed, *Shwarts* teaches away from such a feature. "Because only one bookmark should be inserted in a given page, an affirmative answer to decision step 320 results in the system ignoring the request to create a new bookmark." (*Shwarts* col. 18, line 64 to col. 19, line 1).

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**CONCLUSION**

Applicants respectfully request reconsideration of the rejection of the claims and look forward to passage to issue of the present application at the earliest convenience of the Office. In the event the Examiner wishes to contact applicants' representative for any reason, he should not hesitate to contact the undersigned at the number indicated below.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW THE CHANGES MADE****IN THE CLAIMS**

1. (Amended) In a computer system having a graphical user interface including a display and a selection device, a method of bookmarking a document rendered on the display, the method comprising the steps of:

receiving a first selection signal indicative of the selection device pointing to a desired part of the document; and

responsive to the first selection signal, displaying a visual indicator representative of a bookmark with the desired part of the document; and

responsive to the selection signal, generating a bookmark object represented by the visual indicator,

wherein the visual indicator is displayed at least partially outside of the document,

wherein the bookmark object comprises user-modifiable properties corresponding to the visual indicator.

8. (Amended) The method of claim 71, wherein the bookmark object is generated within a user space separate from the document.

9. (Amended) The method of claim 71, wherein the bookmark object comprises information linking the bookmark object to the desired part of the document.

12. (Amended) The method of claim 71, further comprising steps of:

receiving a removal signal corresponding to the visual indicator; and

responsive to the removal signal, removing, from the display, the visual indicator and eliminating the bookmark object.

20. (Amended) A computer-readable medium comprising computer-executable components for bookmarking a document rendered on a display, the computer-executable components comprising:  
a receiver component that is capable of taking as input a first selection signal indicating

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selection of a desired part of the document; and

a display component that is capable of causing, in response to the first selection signal, a visual indicator to be displayed with the desired part of the document, wherin the display component is capable of causing the visual indicator to be displayed at least partially outside of the document; and

a generating component that, responsive to the first selection signal, is capable of creating a bookmark object represented by the visual indicator, wherein the generating component is capable of providing, as part of the bookmark object, user-modifiable properties corresponding to the visual indicator.

29. (Amended) The computer-readable medium of claim 26, wherein the generating component is capable of providing, as part of the bookmark object, user-modifiable properties corresponding to the visual indicator, the user-modifiable properties comprising information defining at least one of: a color of the visual indicator, a shape of the visual indicator, a size of the visual indicator, a placement of the visual indicator, a font of the visual indicator, a title of the visual indicator and textual content of the visual indicator.

36. (Amended) A computer-readable medium having stored thereon a data structure comprising:

a first data field comprising information linking the data structure to a document; and

a second data field comprising information identifying a part of the document being marked by the data structure, wherein the second data field comprises information identifying the part of the document being marked by the data structure that is at least partially outside of the document; and

a third data field comprising information regarding user-modifiable properties of a visual indicator corresponding to the data structure.

41. (Amended) The computer-readable medium of claim 4036, wherein the information regarding user-modifiable properties comprises information defining at least one of: a color of the visual indicator, a shape of the visual indicator, a size of the visual indicator, a placement of the visual indicator, a font of the visual indicator, a title of the visual indicator and textual content of the visual indicator or links to other locations.